

**FROMMER LAWRENCE & HAUG LLP**

745 Fifth Avenue
New York, New York 10151
Telephone: (212) 588-0800
Facsimile: (212) 588-0500
E-mail: Firm@flhlaw.com

FACSIMILE COVER LETTER

To: United States Patent and Trademark Office
IDS AFTER ALLOWANCE

Facsimile: (703) 746-4000

From: Thomas J. Kowalski / Angela M. Collison

Date: October 19, 2004

Re: U.S. Application Serial No. 09/805,427
Our Ref.: 670001-2002.5

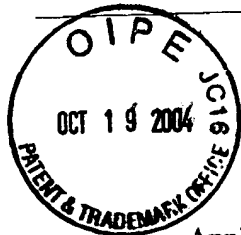
Number of Pages: 6
(including cover page)

If you do not receive all pages or are unable to read the transmission, please call and ask for Jennifer Archer (Ext. 2012).

CONFIDENTIALITY NOTICE

The documents accompanying this transmission contain confidential information intended for a specific individual and purpose. The information is private, and is legally protected by law. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution, or the taking of any action in reliance on the contents of this facsimile is strictly prohibited.

00205153

PATENT
670001-2002.5**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Andersen et al.
Serial No. : 09/805,427
Filed : March 13, 2001
Title : HYBRIDS OF M. TUBERCULOSIS ANTIGENS
Group Art Unit : 1645
Examiner : Rodney P. Swartz, Ph.D

745 Fifth Avenue, New York, NY 10151

FACSIMILE

I hereby certify that this paper is being facsimile transmitted to the
Patent and Trademark Office on the date shown below.

Angela M. Collison, Reg. No. 51,107

Type or print name of
person signing certification

Signature

October 19, 2004

Date of Signature

INFORMATION DISCLOSURE STATEMENT

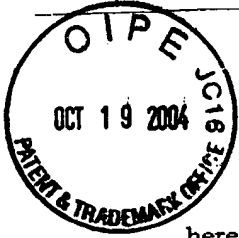
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner's attention is respectfully directed to the document listed on the enclosed PTO-1449, namely U.S. Patent No. 5,955,077, which was cited by the Examiner during prosecution of U.S. Application Serial No. 09/804,980, a co-pending application. Both U.S. Application Serial No. 09/804,980 and the present application claim priority to U.S. Application Serial No. 09/289,388.

This information disclosure is not a representation that the cited document is considered pertinent, or that the cited documents are indeed prior art. And, it is believed that the document cited herein presents no new issues requiring any further search or examination.

00226216

PATENT
670001-2002.5

It is respectfully requested that the Examiner consider and make of record the document herein cited and that a copy of Form PTO-1449 be initialed by the Examiner and returned to the undersigned. To the extent that a Petition is required for entry, this paper is to serve as such.

As this Information Disclosure Statement is being filed concurrently with the payment of the issue fee (by first class mail), the Commissioner is authorized to charge any required fees or credit any overpayment in fees to Deposit Acct. No. 50-0320.

And, in this regard, it is noted that the Rules and the MPEP do not prohibit the Examiner from considering and making of record documents cited at this stage of the prosecution.

37 C.F.R. § 1.97(i) provides that after the Notice of Allowance, the applicant does not have a right to have references cited in an IDS considered.

However, if an IDS filed after the Notice of Allowance is received by an Examiner, and he decides (1) to consider each document, (2) initial the IDS to indicate that he has done so and (3) the documents cited are to appear on the front of the patent, there is nothing in 37 C.F.R. § 1.97(i) to prevent him from doing so, as is respectfully requested in this application. *See also* 37 C.F.R. §§ 1.181-1.183; namely that acceptance of this Information Disclosure Statement by the Examiner can be within 37 C.F.R. §§ 1.181-1.183, especially because non-acceptance of it can result in the Applicants requesting continued prosecution which can cause a loss of patent term.

The actions of the Examiner in considering the document cited herein are consistent with the defined mission of the USPTO to help applicants get valid and enforceable patents on their Inventions. *See, e.g.*, 1998 USPTO Annual Report by then Commissioner Bruce A. Lehman available on the USPTO website at <http://www.uspto.gov/web/offices/com/annual/1998/a98r-2.htm#Topic11>, "The mission of the patent business area is to help our customers get patents; its performance goal is to grant patents to inventors for their discoveries."

And if in considering a document in an IDS filed after a Notice of Allowance, an Examiner determined that the document would establish a *prima facie* case of unpatentability of an allowed claim, the Examiner has authority to withdraw the Notice of Allowance, reopen the prosecution of the application and reject the claim on the recently cited document.

Indeed, 37 C.F.R. § 1.313(a) provides that "[a]pplications may be withdrawn from issue for further action at the initiative of the" USPTO. 37 C.F.R. § 1.313(b) further provides that the USPTO can withdraw an application from issue after payment of the issue fee due to, *inter alia*, unpatentability. Section 1308 of the MPEP provides that:

00226216

PATENT
670001-2002.5

An application may be removed from the Office of Patent Publication, without it being withdrawn from issue under 37 CFR 1.313(b), to **permit the examiner to consider an information disclosure statement** or whether one or more claims are unpatentable. Only if such consideration results in a determination that one or more claims are unpatentable does 37 CFR 1.313(b) authorize the application to be withdrawn from issue. [emphasis added]

Thus, 37 C.F.R. § 1.97(i) does not prohibit the Examiner from considering an IDS that may not comply with 37 C.F.R. §§ 1.97 and 1.98, such as an IDS after allowance that may not comply with 37 C.F.R. §§ 1.97 and 1.98. Rather, 37 C.F.R. 1.97(i) is a procedural safeguard that prevents Applicants from expecting or insisting upon consideration of an IDS that may not comply with 37 C.F.R. §§ 1.97 and 1.98. And, in fact, as the application is now electronic, consideration of such an Information Disclosure Statement does not require the physical removal or transfer of the application itself, thereby simplifying the process and reducing any hardship on the Examiner.

Therefore, it is respectfully requested under all of the Rules, including 37 C.F.R. §§ 1.181-1.183 that the documents cited herein be considered and made of record. The Examiner is invited to contact the undersigned by telephone at (212) 588-0800 should there be any questions.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicant

By: Thomas J. Kowalski by Angela M. Collison

Thomas J. Kowalski
Reg. No. 32,147
Angela M. Collison
Reg. No. 51,107



10/19/2004 11:28 FAX 12125880500

FROMMER LAWRENCE & HAUG

005

Sheet 1 of 1

Based on Form PTO-1449
(3/90)

ATTY. DOCKET NO.

670001-2002.5

SERIAL NO.

09/805,427

LIST OF REFERENCES CITED BY APPLICANT
(Use several sheets if necessary)

APPLICANT

ANDERSEN ET AL.

FILING DATE

MARCH 13, 2001

GROUP

1645

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	AA	5,955,077	9/21/1999	ANDERSEN et al.			
	AB						

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
	AC						
	AD						

OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)

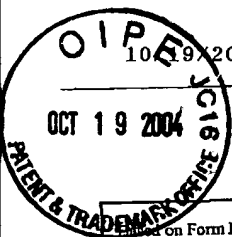
	AE		
	AF		
	AG		
	AH		
	AI		
	AJ		
	AK		
	AL		
	AM		
	AN		
	AO		
	AP		
	AQ		
	AR		
	AS		
	AT		
	AU		

EXAMINER

DATE CONSIDERED

* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

00116091



10/19/2004 11:28 FAX 12125880500

FROMMER LAWRENCE & HAUG

006

Sheet 1 of 1

LIST OF REFERENCES CITED BY APPLICANT (Use several sheets if necessary)				ATTY. DOCKET NO. 670001-2002.5		SERIAL NO. 09/805,427	
				APPLICANT ANDERSEN ET AL.			
				FILING DATE MARCH 13, 2001		GROUP 1645	
U.S. PATENT DOCUMENTS							
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
	AA	5,955,077	9/21/1999	ANDERSEN et al.			
	AB						
FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
	AC						
	AD						
OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)							
	AE						
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						
	AL						
	AM						
	AN						
	AO						
	AP						
	AQ						
	AR						
	AS						
	AT						
	AU						
EXAMINER				DATE CONSIDERED			
* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.							

00116091